

Hearing:
August 11, 1998

Paper No. 22
BAC

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re China Grill, Inc.

Serial No. 74/725,766
Serial No. 74/725,767
Serial No. 75/015,078

David Friedland of Lott & Friedland, P.A. for China Grill,
Inc.

Karen Kuhlke, Trademark Examining Attorney, Law Office 105
(Thomas Howell, Managing Attorney).

Before Simms, Hairston, and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Three applications were filed by China Grill, Inc. to register three different marks, each of which includes the words CHINA GRILL, and all three of which are for services identified as "restaurant and cocktail lounge services."

Application Serial No. 74/725,766 was filed on September 6, 1995, to register the mark CHINA GRILL based on a claimed first use date of October 1, 1987.

Ser. Nos. 74/725766, 74/725767 & 75/015078

Application Serial No. 74/725,767 was filed on September 6, 1995, to register the mark shown below

based on a claimed first use date of October 1, 1987. The application includes a statement that "the lining in the mark is a feature of the mark and does not indicate color."

Application Serial No. 75/015,078 was filed on November 6, 1995, to register the mark shown below

based on applicant's bona fide intention to use the mark in commerce. The application includes a statement that "the stippling in the mark is a feature of the mark and does not indicate color."

Registration of the word mark has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C.

§1052(e)(1), on the basis that, when used on applicant's services, the applied-for mark CHINA GRILL is merely descriptive of them.

Registration of the two marks which include designs has been finally refused based on applicant's failure to comply with a requirement to disclaim the words "China grill" apart from the mark as shown, under Section 6 of the Trademark Act, 15 U.S.C. §1056.¹

Applicant has appealed, and briefs have been filed. An oral hearing was held before the Board on August 11, 1998.

Applicant's motion for consolidation was granted by the Board on June 23, 1997. Thus, we have issued this single opinion. We affirm the refusal to register in all three cases.

The Examining Attorney contends that the word CHINA is descriptive of a type of cuisine, and conveys to the average purchaser that the restaurant serves food that has a Chinese quality and characteristic; and that the word GRILL is generic for a particular type of eating

¹ The Board notes that in the two use-based applications (for the marks CHINA GRILL and CHINA GRILL and design) the Examining Attorney both initially and throughout the examination process suggested that applicant submit a claim of acquired distinctiveness based on five years substantially exclusive and continuous use with regard to the word CHINA and disclaim the word GRILL. We note the following comment by the Court of Appeals for the Federal Circuit in the case of *In re K-T Zoe Furniture Inc.*, 16 F.3d 390, 29 USPQ2d 1787, 1789 (Fed. Cir. 1994): "The purpose of the disclaimer practice is to enable, not to bar, registration. ... the practice can facilitate the commercial purposes of the trademark law, by enabling

establishment, a type of food served at a restaurant, the method by which the food is prepared, and the apparatus on which the food is prepared. Thus, the combined words CHINA GRILL immediately describe a characteristic, feature or quality of applicant's restaurant services.

In support of her refusals to register, the Examining Attorney submitted (i) several third-party registrations to show that marks for restaurant services which include the word "CHINA" (or other words denoting a country, e.g., "India," "Mexico," "Japan," "France") registered under Section 2(f) or with a disclaimer²; (ii) copies of several excerpted articles from Nexis to show that applicant in fact serves Chinese food in addition to its other offerings; (iii) several third-party registrations to show that marks for restaurant services which include the word "grill" registered on the Supplemental Register, but also included a disclaimer of the generic word "grill"³; (iv) copies of several excerpted articles from Nexis to show

registration of a distinctive style of displaying words when the words themselves are not registrable."

² Included in these third-party registrations was a copy of applicant's Registration No. 1,520,267, issued January 10, 1989 for the mark CHINA GRILL and the design of a shield and chopsticks (as shown in application Serial No. 74/725,767) for restaurant and cocktail lounge services, and in which applicant disclaimed the terms "CHINA GRILL." This registration was cancelled under Section 8 in 1995.

³ See TMEP §1213.02(b).

that the term "grill" denotes a type of restaurant; and (v) Webster's Third New International Dictionary definition of "grill" as "3: a grillroom or other usu. informal restaurant."

Applicant, in urging reversal of the refusals to register, argues that it serves "'world cuisine,' an adventurous approach to dining that takes ingredients, flavors and techniques from around the globe and presents them in a characteristic climate..." (applicant's July 3, 1996 response to an Office action, pp. 3-4); that applicant does not serve exclusively or even primarily Chinese cuisine; that applicant's restaurants do not have the appearance of Chinese restaurants as the public might expect in the United States; and that both applicant's own advertisements as well as independent media coverage show that the term "CHINA" does not describe a significant characteristic, attribute or feature of applicant's services. Based thereon, applicant contends that the term CHINA is not merely descriptive of applicant's services.

Applicant further argues that one definition from The American Heritage College Dictionary of the term "grill" as a verb is "to broil on a gridiron," and definitions as a noun include "a cooking surface of parallel metal bars, a gridiron" and "food cooked by broiling or grilling"; that

none of these definitions are inclusive of or synonymous with the word restaurant or restaurant services; and therefore the term "grill" is not a generic term for applicant's restaurants.

In support of its arguments, applicant submitted (i) copies of several articles and restaurant reviews in which the writers refer to applicant's "world cuisine," and/or make references to applicant's positioning itself as neither a grill nor a Chinese restaurant; (ii) the above-mentioned dictionary definition of "grill"; and (iii) one of applicant's advertisements, with an accompanying declaration of Mr. Ephraim Kadish, applicant's executive chef. Also, in each of the two use-based applications, applicant submitted a videotape of two clips which appear to be two separate television food or restaurant review shows, both carried on the "Food Network" television channel.

It is well settled that a term is merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it immediately conveys information concerning an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215

(CCPA 1978). It is not necessary that a term or phrase describe all of the properties or characteristics or features or functions of the goods or services in order for it to be considered merely descriptive thereof; rather, it is sufficient if the term or phrase describes a significant attribute or idea about them. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982).

The question of whether a particular term or phrase is merely descriptive must be determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the possible significance that the term or phrase is likely to have to the average purchaser of the goods or services because of the manner in which it is used. See *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). See also, *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); and 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:66-11:71 (1998).

The specimens of record in application Serial No. 74/725,766 (for the mark CHINA GRILL) include applicant's menu which lists a variety of items, many of which are

Chinese in nature, such as, "Peking duck salad," "Confucius chicken salad," "bamboo steamed vegetables," "five vegetable fried rice," "sizzling whole fish," "broccoli rabe dumplings," "stir fried sesame citrus noodles," and "duck pancakes." In addition, in the videotape submitted by applicant, when Mr. Kadish, applicant's executive chef, showed a prepared dish which he called "Confucius chicken salad," the host asked if some places call it "Chinese chicken salad," and Mr. Kadish responded "yes."

The Examining Attorney submitted Nexis stories to show that applicant in fact serves Chinese food, and that some publicity so indicates. Three examples of these excerpted stories follow:

"...Ave. is more known for its club scene, but in a garish pseudo-Art Deco structure there stands the China Grill, a pricey gourmet Chinese restaurant that has become popular with some celebrities. Across the street..." appearing in both the Chicago Tribune and The Plain Dealer, February 23, 1997;

"In the fall, Jeffrey Chodonow, the owner of China Grill restaurants in Manhattan and Miami Beach, will depart from his successful California-Chinese formula and open a Chinese-Latino restaurant at Morgans, Ira Schrager's hotel at 237 Madison Avenue. ...," The New York Times, January 31, 1996; and

"China Grill is an airy, clamorous and friendly place with soaring ceilings and marble floors where East meets West pleasingly on the plates....," The New York Times, November 3, 1996.

Thus, at least some reviews and media stories refer to applicant's restaurants as Chinese restaurants. Even if the purchasing public sees those reviews and stories emphasized by applicant, as well as applicant's own advertisements for its restaurants, they will not necessarily make the distinction urged by applicant, that is, that applicant's restaurants feature "world cuisine," not Chinese or grilled food. Rather, consumers will give the ordinary meanings to the words which comprise the name of the restaurants, the words "CHINA" and "GRILL." This is especially true of patrons of applicant's restaurants inasmuch as applicant's own menu features many Chinese dishes (albeit not exclusively), and the food at applicant's restaurants is primarily grilled as a method of preparation.

Even if applicant serves dishes which are a combination of ethnic influences and ingredients, the record is clear that there is an oriental overtone, and that applicant's restaurants serve Chinese cuisine and are heavily influenced by Chinese cuisine. In order for the

term "CHINA" to be considered merely descriptive for restaurant services it is not necessary that applicant's restaurants have a traditional Chinese decor and that applicant serve only Chinese food. Thus, while Chinese food and decor may not be the sole emphasis at applicant's restaurants, nonetheless, it is clear that the Chinese influence is not incidental to applicant's restaurants.⁴ It is a significant characteristic of applicant's restaurants.

Regarding the question of whether the word "grill" is generic in reference to restaurant services, the totality of evidence establishes that it is. See H. Marvin Ginn Corp. v. International Association of Fire Chiefs, inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

The Examining Attorney submitted Nexis stories wherein various eating establishments are referred to as a "grill" or a "bar and grill"; and the dictionary definition in the record of the term "grill" as "a grillroom or other usu. informal restaurant." In addition, applicant's menu includes items clearly referring to grilled food, such as "grilled dry aged Szechuan beef," "grilled rosemary scallops," "grilled organic chicken," and "grilled garlic

⁴ In an article submitted by applicant from the November 23, 1995 Sunpost, the writer stated, inter alia, the following: "He [chef Kadish] takes traditional dishes and adds an oriental flavor."

shrimp"; and in the videotape when a television food show host asked Mr. Kadish, applicant's executive chef, if the cooking at the restaurant is done on grills or woks, he responded "primarily grills, lots of woks."

The term "grill" designates a type of establishment that serves food (as well as the method by which food is prepared, and the apparatus on which food is prepared); and that in the context of applicant's services the term is so understood by the relevant purchasing public. "Grill" is generic for applicant's restaurant and cocktail lounge services, thus requiring a disclaimer. See *In re Medical Disposables Co.*, 25 USPQ2d 1801 (TTAB 1992).

We find that the words CHINA GRILL, when used in connection with the involved services, immediately convey the idea of restaurant services featuring at least some grilled Chinese food. That is, these words immediately and without conjecture or speculation describe a significant feature or characteristic of applicant's services. See *In re K-T Zoe Furniture Inc.*, 16 F.3d 390, 29 USPQ2d 1787 (Fed. Cir. 1994) (wherein the Court upheld the Board's holding that "the sofa and chair company" in a stylized form is "strongly descriptive" of custom manufacturing of furniture upholstered with fabrics furnished or pre-selected by customers and thus unregistrable without a

disclaimer of the words); In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1859) (wherein the Court affirmed the Board's holding that the words "FirstTier" in a word and design mark are the equivalent of "first tier," which is merely descriptive of banking services and thus unregistrable without a disclaimer of the term); and In re Pencils, 9 USPQ2d 1410 (TTAB 1988) (wherein the Board held the word "pencils" in a word and design mark is merely descriptive of retail stationery and office supply services and thus unregistrable without a disclaimer of the word).

Moreover, the words CHINA GRILL do not involve any incongruous word combinations, and no imagination is needed to understand the meaning of CHINA GRILL in reference to restaurant and cocktail lounge services. See In re Cryomedical Sciences Inc., 32 USPQ2d 1377 (TTAB 1994) (SMARTPROBE merely descriptive of disposable cryosurgical probes); In re Copytele Inc., 31 USPQ2d 1540 (TTAB 1994) (SCREEN FAX PHONE merely descriptive of facsimile terminals employing electrophoretic displays); In re Eden Foods Inc., 24 USPQ2d 1757 (TTAB 1992) (DOUBLE CERTIFIED ORGANIC held merely descriptive of pasta); Domino's Pizza Inc. v. Little Caesar Enterprises Inc. 7 USPQ2d 1359 (TTAB 1988) (SINGLE, DOUBLE and TRIPLE merely descriptive of applicant's pizza);

In re IBP, Inc., 228 USPQ 304 (TTAB 1985) (requirement for a disclaimer of the merely descriptive terms "select trim" for pork affirmed); and In re Truckwriters Inc., 219 USPQ 1227 (TTAB 1983), aff'd unpubl'd Appeal No. 84-689 (Fed. Cir. November 1, 1984) (requirement for a disclaimer of the merely descriptive term "writers" for insurance agency services affirmed).

Further, even if applicant is the first (and/or only) entity to use the term CHINA GRILL in relation to restaurant and cocktail lounge services is not dispositive where, as here, the term unquestionably projects a merely descriptive connotation. See In re Tekdyne Inc., 33 USPQ2d 1949, 1953 (TTAB 1994), and cases cited therein.

Decision: The refusal to register the mark CHINA GRILL (application Serial No. 74/725,766) under Section 2(e)(1) is affirmed.

The requirement under Section 6 for a disclaimer of the words CHINA GRILL in application Serial Nos. 74/725,767 and 75/015,078 is affirmed. However, this decision will be set aside for these two applications and these two word and design marks will be published for opposition if applicant,

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no later than thirty days from the mailing date hereof,
submits an appropriate disclaimer of 'CHINA GRILL.' See
Trademark Rule 2.142(g).

R. L. Simms

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board